
63. (Amended) A book as claimed in claim 44 wherein at least one of said plurality of sheets is blank.

a4 64. (Amended) A method as claimed in claim 44 further comprising pre-printing information related to the book theme on at least one of said plurality of sheets.

65. (Amended) A method as claimed in claim 44 wherein said theme related information is a story.

66. (Amended) A method as claimed in claim 44 wherein said theme related information is non-fictional.

67. (Amended) A method as claimed in claim 44 wherein said theme related information is fictional.

REMARKS

Summary of Examiner's Action

Claims 1-68 are pending in the application. The Examiner rejected in the application claims 10, 23-25, 31, 32, 46, and 60 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 1-36, 43-62 and 68 were rejected under 35 U.S.C. § 102(e) as being anticipated by Krull et al US Patent No. 5,988,366 (hereinafter "Krull"). Claims 37, 38, 39

40-42 and 63-67 are rejected under 35 U.S.C. § 103(a), which formed the basis for obviousness rejections.

Summary of Applicants' Amendments

Claims 1, 37-42, 44, and 63-67 have been amended in order to more particularly point out and distinctly claim the subject matter which the applicants regard as their invention.

The Rejection of Claims 10, 23-25, 31, 32, 46, and 60
Under 35 U.S.C. § 112

The claims were rejected under 35 U.S.C. § 112 as being "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Examiner alleges that "the terms 'diameter of coin', 'commemorative event', 'historic event', and an 'athlete' are all relative." (Examiner's Action, page 2). Furthermore, the Examiner states "these terms could change in value and definition through time rendering the claims indefinite ton [sic] what the limitations are." (Examiner's Action, page 2).

The rejection of claims 10, 23-25, 31, 32, 46, and 60 is respectfully traversed.

Claims 10, 23-25, 31, 32, 46, and 60

The United States Mint creates a novelty for a coin or group of coins by associating them to a "commemorative

event", a "historic event", or an "athlete". In doing so, it creates a novelty in collecting this memorabilia and can directly affect sales of an associated coin. The present invention displays such coins in such a manner to increase associability with the "commemorative event", "historic event", and "athlete" that is an attribute of the coin. Applicants respectfully disagree with the Examiner who alleges that these terms are relative.

According to Merriam-Webster's Collegiate Dictionary, ISBN 0-87779-709-9, the definition of "relative" is to be "not absolute or independent". The terms "commemorative event", "historic event", and "athlete" are not relative because their meanings are absolute and respectively dependent upon an "event", a "fact", and/or a "person". They are also dependent upon the themes of an absolute object such as a coin from the United States Mint. The relativity of the "diameter of a coin" holds no substance since it is a numerical constant and dependent upon the circumference of a circle. Relativity does not exist in such a way that it fails to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Furthermore, a "commemorative event", a "historic event" or an "athlete" does not hold a value and the "diameter of a coin" is a numerical constant and does not change in value or definition through time. For example, the value of the diameter of a February 2001 New York Quarter is constant

throughout time. A "commemorative event", "historic event" or an "athlete" have meanings that are defined by society and time just like the terms a "continent", "region", or "state". Therefore, the present invention, or any invention, will always be put into context of the elements originally accompanying it. The rejected terms are based on the type of "event", "fact", and "person" whose definitions are clear and distinctly point out the subject matter to which the present invention pertains. Applicants respectfully submit that claims 10, 23-25, 31, 32, 46, and 60 are allowable under 35 U.S.C. § 112.

The Rejection of Claims 1-36, 43-62, and 68

Under 35 U.S.C. § 102(e)

The claims were rejected under 35 U.S.C. § 102(e) as being anticipated by Krull et al US Patent No. 5,988,366. The Examiner alleged that "Krull discloses a card stock book and inherently disclosed a method for making a book for displaying one or more coins related to a theme comprising joined first and second book covers where at least one cover defines an interior or exterior coin receivable aperture and the theme is displayed on at least one of the covers with at least one sheet between the book covers" (Examiner's Action, page 3).

Applicants have obviated the Examiner's rejection by amending claims 1-36, 43-62, and 68 to incorporate the elements of claims 36 and 62.

Claims 1-36, 43-62, and 68

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that forms the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(C) if this title before the invention thereof by the applicant for patent.

Amended claims 1 and 44 do not describe an invention that was described in a patent granted on an application for patent by another filed in the United States before the invention thereof since Krull's invention does not contain the plurality of fastened pages bound to at least one of said first and second book covers as shown below.

Krull uses the term "book" throughout his patent. However, Krull does not disclose a "book", but a "folder". The definition of a folder according to "Webster's New Collegiate Dictionary", ISBN 0-87779-348-4, is "a folded cover or large envelope for holding or filing loose papers." The definition according to "Webster's Encyclopedia Unabridged Dictionary New Revised Edition", ISBN 0-517-11864-5, is "a folded sheet of light cardboard used to cover or hold papers, letters, etc." Krull discloses a "folder" in claiming

sections that "are interconnected and foldable relative one another about an axis" (see col. 5, claim 2 Fig. 5).

The definition of a "book" is different from that of a "folder", as defined by the present invention. The definition of a "book" according to "Webster's New Collegiate Dictionary" is "a set of written, printed, or blank sheets bound together into a volume." The definition according to "Webster's Encyclopedia Unabridged Dictionary" is "a written or printed work of some length, as a treatise, novel, or other literary composition, esp. on consecutive sheets of paper fastened or bound together in a volume." Similarly, the present invention claims and defines a "book" that will "include one or more sheets 36 of paper" (page 9, line 39) in which "one or more of sheets 36 may be blank, or all sheets 36 may contain text and/or pictures that describe or otherwise relate to theme 16" (page 10, lines 1-2 and Fig. 4). Therefore, Krull does not show or suggest the present invention.

Additionally, the "page" in Krull's invention, referred to by the Examiner, is actually referred to as a "cover" in claim 5 of Krull's patent. This sole "cover" is not directly attached to the folder and as stated in claim 5 is "disposed over the map and the coin holders". In the present invention, the plurality of sheets provided in amended claims 1 and 44 is not used as a sole protective cover. Those skilled in the art will respect these differences and

acknowledge a unique apparatus as defined in amended claim 1 and subsequent dependent claims (claims 2-43) and a unique method as defined in amended claim 44 and subsequent dependent claims (claims 45-68).

Therefore, applicants respectfully submit that amended claims 1 and 44 and the dependent claims 2-36, 43, 45-62, and 68 are allowable as they are not anticipated as described in 35 U.S.C. § 102(e).

The Rejection of Claims 14-17, 31, 32 and 50-53

Under 35 U.S.C. § 102(e)

The claims were rejected under 35 U.S.C. § 102(e) as being anticipated by Krull et al. The Examiner alleges that Krull "discloses the book theme relating [a] it to a commemorative event, a historic event, a non-fictional character, a non-fictional celebrity character, such as a celebrity, and a geographic region being a state(501), a province(504), a country(100), a group of countries, and a geographic region ... where an image related to the theme is displayed in the aperture(140) when the cap is removed, a removable (820 & 822) insert able [sic] into the apertures, where the cap is substantially equal to the diameter of a coin, where the cap displays an image associated with the geographic region related to the book theme, where the image on the cap is the image of the coin (see col. 3,1, 5-15)." (Examiner's Action, page 3). The Examiner also alleges that

"Krull disclose [sic] the image on the cap being the one of the coin. Coins around the world abound with images of a bird, a capitol, a flag or a flower. Hence, Krull inherently discloses the image on the cap being the one of a bird, a capitol, a flag or a flower. Anything could be a theme related to an athlete, such as the country where he/she comes from" (Examiner's Action, page 3).

The rejection of claims 14-17, 31, 32 and 50-53 is respectfully traversed.

Claim 31

Krull discloses in claim 1 of his patent a "map depicting geographical regions". The present invention uses the novelty of a "book" to display or store any objects, and does not use the medium of a "map". Therefore, the theme of a "book" is held in a different context than the theme of a "map" and is not disclosed by Krull.

Claims 14-17, 32, and 50-53

The only segment of Krull's patent that relates a theme to an object associated with the aperture reads "The map 100 serves as an attractive and educational way to store and display "quarter-sized" objects which are distinguishable on a state by state basis. For example, each coin may bear the name and/or outline of its respective state, or some other symbol associated with the state" (col. 2, lines 43-47). Krull only directly discloses that a coin or a "quarter-sized"

object can bear a symbol associated with the respective state on the map.

However, the present invention discloses a size-variable cap and not Krull's "quarter-sized" object or a coin. Applicant infers that Krull discloses this "quarter-sized" object as a substitute for the coin. The coin in Krull's disclosure is the collectible medium that utilizes the display potential of the map. Therefore, Krull's invention does not actually place the symbol on the coin, it merely "stores and displays"(col. 2, line 44) the symbol already present on the coin. Applicants infer that the "quarter-sized" object in Krull has these same limitations and that Krull infers same sized existing collectibles such as tokens to be used as a substitute.

On the other hand, the cap of the present invention has a symbol placed on it for the purpose of creating a display until a suitable coin can be found. This increases the novelty of the display since an outside coin is not critically necessary. The present invention creates the cap and the symbol and then stores and displays them, thus creating an element not found in Krull's patent.

Additionally, the context of the theme of the "book" of the present invention differs from the theme of Krull's map and should not be compared as having the same value or meaning.

Applicants submit that claims 14-17, 32, and 50-53 are allowable under 35 U.S.C. § 102(e) since they depict an element not present in the cited application.

The Rejection of Claims 37, 38, 40-42 and 63-67

Under 35 U.S.C. § 103

The claims were rejected under 35 U.S.C. § 103 as being unpatentable over Krull et al US Patent No. 5,988,366 in view of "The 50 State Quarters" ISBN 0-439-20822X. The Examiner alleges that "'The 50 state Quarters' teaches a book for displaying coins with at least one of the page being a blank page (page 5) and with preprinted information related to the book theme, wherein the themes related information is a fictional or non-fictional story" (Examiner's Action, page 4). The Examiner concluded that "it would have been obvious to one or [sic] ordinary skill in the art at the time the invention was made to modify Krull's invention by incorporating at least one blank page and pages for displaying coins with preprinted information related to the book theme" (Examiner's Action, page 4).

Applicants have incorporated claim 36 into amended claim 1 and 43 in which the rejected claims 37, 38, 40-42, and 63-67 are now dependent upon.

Applicants have obviated the Examiner's rejection by amending the claims to incorporate the elements of claims 1 and 44.

Claims 37, 38, 40-42, and 63-67

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office Action.

(a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The claims that were rejected depend on amended claims which now show the differences required so as they were not obvious at the time the stated invention was made to a person having ordinary skill in the art to which the stated subject matter pertained. Neither the stated invention or the stated subject matter discloses a plurality of pages fastened together and bound to at least one of said first and second book covers and is not obvious under 35 U.S.C. § 103(a). Therefore, applicants respectfully submit that claims 37, 38, 40-42, and 63-67 are allowable.

"The 50 State Quarters", like Krull, discloses a "folder" in which pages that are either blank or contain preprinted information can be placed into. "The 50 State Quarters" is actually two inventions in itself, a folder and a booklet that may be placed inside this folder. Amended claims 1 and 43, in which the claims in question are now dependent upon, discloses applicants' invention as that of a "book" with

one or more coin receivable apertures in which a plurality of fastened pages are attached to. Those skilled in the art will respect these differences and acknowledge a unique apparatus and method for displaying and containing coins through the use of a "book", not a "folder" and is patentable under 35 U.S.C. § 103.

The Rejection of Claim 39 Under 35 U.S.C. § 103(a)

The claim was rejected under 35 U.S.C. § 103(a) as being unpatentable over Krull et al US Patent No. 5,988,366 in view of Ball US Patent No. 2,860,774. The Examiner alleges that "Krull discloses the claimed invention except for at least one page having an aperture that is aligned with one of the apertures in the cover. Ball teaches a book for displaying coins where at least one page(11) having an aperture that is aligned with one of the apertures in the cover(14), (See Figure 5)" (Examiner's Action, page 5). The Examiner concluded that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Krull's display device to have at least one page having an aperture that is aligned with one of the apertures in the cover, as taught by Ball, in order to ensure the coins stayed put and could be displayed in harmony when passing the pages of the book" (Examiner's Action, page 5).

Applicants have obviated the Examiner's rejection by amending claim 39 to incorporate the elements of claim 1.

Claim 39

The Examiner quoted 35 U.S.C. § 103(a), which formed the basis for an obviousness rejection. The claim that was rejected now depends on amended claims which show the differences required so as they were not obvious at the time the stated invention was made to a person having ordinary skill in the art to which the stated subject matter pertained. Neither the stated invention or the stated subject matter discloses a plurality of pages fastened together and bound to at least one of said first and second book covers and is not obvious under 35 U.S.C. § 103(a). Therefore, applicant respectfully submits that claim 39 is allowable.

Conclusion

For the reasons set forth above, applicant respectfully submits that this application is in condition for allowance. Reconsideration and prompt allowance of this application are respectfully requested.

Respectfully submitted,

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APPENDIX

In The Claims

Please amend claims 1, 31, 32, 37-42, 44, and 63-67 as follows:

¹⁰³ 1. A book capable of displaying one or more coins related to its theme, comprising:

a first book cover;

a second book cover joined to said first book cover, wherein at least one of said first and second book covers defines one of more coin receivable apertures, and wherein the book theme is displayed on at least one of said first and second book covers; and

, a plurality of sheets fastened together and attached to at least one of said first and second book covers.

¹⁰³ 37. (Amended) A book as claimed in claim [36] 1 wherein at least one of said [at least one] plurality of sheets is blank.

¹⁰³ 38. (Amended) A book as claimed in claim [36] 1 wherein at least one of said [at least one] plurality of sheets provides preprinted information related to said book theme.

39. (Amended) A book as claimed in claim [36] 1 wherein at least one sheet defines at least one aperture that is aligned with at least one of said first and second book cover apertures.

40. (Amended) A book as claimed in claim [36] 1 wherein said theme related information is a story.

41. (Amended) A book as claimed in claim [36] 1 wherein said theme related information is non-fictional.

42. (Amended) A book as claimed in claim [36] 1 wherein said theme related information is fictional.

44. A method of generating a book capable of displaying one or more coins related to its theme comprising:

providing a first book cover; and

joining a second book cover to said first book cover, wherein at least one of said first and second book covers defines one or more coin receivable apertures, and wherein at least one of said first and second book covers displays the book theme[.]; and

attaching a plurality of sheets fastened together to at least one of said first and second book covers.

63. (Amended) A book as claimed in claim [62]
44 wherein at least one of said [at least one] plurality of
sheets is blank.

64. (Amended) A method as claimed in claim [62]
44 further comprising pre-printing information related to the
book theme on at least one of said [at least one] plurality of
sheets.

65. (Amended) A method as claimed in claim [62]
44 wherein said theme related information is a story.

66. (Amended) A method as claimed in claim [62]
44 wherein said theme related information is non-fictional.

67. (Amended) A method as claimed in claim [62]
44 wherein said theme related information is fictional.